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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/535,005	03/23/2000	William S. Bess	PD A0000259-03EJF	1060

7590 10/31/2003

FITZPATRICK, CELLA, HARPER & SCINTO  
30 Rockefeller Plaza  
New York, NY 10112-3801

EXAMINER

PESELEV, ELLI

ART UNIT	PAPER NUMBER
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1623

DATE MAILED: 10/31/2003

29

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action**

Applicati n No.

09/535,005

Applicant(s)

BESS ET AL.

Examiner

Elli Peselev

Art Unit

1623

--The MAILING DATE of this communication appears on the c ver sheet with the correspondence address --

THE REPLY FILED 01 October 2003 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

**PERIOD FOR REPLY** [check either a) or b)]

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on \_\_\_\_\_. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☒ The proposed amendment(s) will not be entered because:
- (a) ☒ they raise new issues that would require further consideration and/or search (see NOTE below);
- (b) ☒ they raise the issue of new matter (see Note below);
- (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☒ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: See Continuation Sheet.

3. ☐ Applicant's reply has overcome the following rejection(s): \_\_\_\_\_.
4. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Continuation Sheet.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☒ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: \_\_\_\_\_.

Claim(s) objected to: \_\_\_\_\_.

Claim(s) rejected: 1-4, 7, 14-19, 21, 22 and 25-31.

Claim(s) withdrawn from consideration: 5, 6, 8-13, 20 and 32.

8. ☐ The proposed drawing correction filed on \_\_\_\_\_ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_.
10. ☐ Other: \_\_\_\_\_

*elli peselev*  
ELLI PESELEV  
PRIMARY EXAMINER  
GROUP 1800

Continuation of 2. NOTE: The election requirement of July 26, 2001 has not been withdrawn and still stands. The requirement stated that claims 22-24 are directed to specific species while claims 1-20 and 25-27 are generic. In response to applicant's election, the traversal was found persuasive only insofar as claims 22-24 were concerned.

Applicant contends that the present invention relates to a solid film adapted to adhere and dissolve in the mouth. None of the claims state that the claimed film is adapted to adhere and dissolve in the mouth. Ozaki et al state that pullulan has film-forming ability and can be used with pharmaceuticals (column 1, lines 19-25). Eichman discloses the pharmaceutical encompassed by the instant claims. A person having ordinary skill in the art at the time the instant invention was made would have been motivated to use pullulan for its film-forming ability with any pharmaceutical including those disclosed by Eichman.

The term "solid" (claims 1-22 and 25-34) and the terminology "pharmaceutically active agent is present at a ratio to said taste masking agent of 1:3 to 3:1" (claim 1) is not disclosed or suggested by the specification as originally filed. Note that page 17 of the specification provides support for "the pharmaceutically active agent adsorbate to ion exchange resin adsorbent in the adsorption complex is about 1:3 to about 3:1" i.e. taste masking agent is not the same as ion exchange resin.

The newly presented claims 33-34 would require further search and consideration.